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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,625	08/01/2000	Andreas Helfenstein	67736	6857
23872	7590	05/17/2005	EXAMINER	
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			NGUYEN, ANTHONY H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,625

Applicant(s)

HELFENSTEIN ET AL.

Examiner

Anthony H. Nguyen

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,9,11,12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8,9,11,12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

Applicant stated that the form PTO-1449 has been provided. However, the form has not been received. Therefore, the objection to the IDS is repeated.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 11, 12 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Niedermaier et al. (US 5,123,316).

With respect to claims 1,3,4, 6, 11, 12 and 14-21, Niedermaier et al. teaches a process and a device for determining cutting positions of web strands which includes the steps of bringing together the web strands into a strand to be bound, recording each individual web strand 9.1-9.8 by the web strand sensors 64.1-64.8 and recording a common measured value for cutting the position of the strips or the web strands 16 and 17 by the reading heads or sensors 59, 60

which sense the cutting register marks and compare to a nominal value or a common value via a control device 62 before the web strands are brought together to a cutting device 19 (Fig.1). See Niedermaier et al., claim 1, col.4 lines 35-48. and col.6 lines 5-14. With respect to claim 4, Niedermaier et al. teaches the use of synchronous control 63 and 66 (Niedermaier et al., Fig.1) that are electronically connected to the strip-cutting device 19 and a register control device 65 for control the cutting position of the web strands. With respect to claims 5 and 13, the values for cutting positions which are set manually at the time of start-up the press and the use of a common control device and individual control devices which send adjust signals to the common control device while not specifically stated in Niedermaier et al. are necessary to provide an operative press.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Niedermaier et al. (US 5,123,316) in view of Bergland et al. (US 5,016,182).

Niedermaier et al. teaches all that is claimed, except for the optical scanner, which detects optical print marks, is not clearly shown. Bergland et al. teaches a register control means having an optical scanner 38 which detects optical marks printed on the web (W) (Bergland et al., Fig. 1,

and the paragraph bridging columns 5 and 6). In view of the teaching of Bergland et al., it would have been obvious to one of ordinary skill in the art to modify the device of Niedermaier et al. by substituting the optical scanner as taught by Bergland et al. to permit more precise control the cutting position on a web or a web strand.

Response to Arguments

Applicants' arguments filed on March 1, 2003 have been fully considered but they are not persuasive of any error in the above rejections.

Applicant argues that Niedermaier et al. fails to teach or suggest the steps and structure for determining the cutting position of a plurality of web strands as recited. Specifically, applicant argues that Niedermaier et al. does not teach the step for forming an adjusting signal for the strand to be bound in a common control device and the individual control device which forms individual adjusting signals for the web strands as recited in claims 1, 6 and 14.

However, as explained above, Niedermaier et al. teaches the method and a device for determining cutting positions of web strands including the step of recording each individual web strand, recording a common measured value for cutting the position of the strips. Note that Niedermaier et al. teaches the steps of forming an adjusting signal and using the adjusting signals for the strand to be bound. For example, the adjusting device 62 of Niedermaier et al. controls the motors 53 of the strand or strip-cutting device 18 in accordance with the strand cutting register deviation which receives signal from the reading heads or sensors 59, 60 which in turn synchronizes with the strand cutting device 19 via the synchronous controllers 63 and the register control device. Thus, the steps of forming and using the adjusting signals via the

common control device and individual control devices is inherent in Niedermaier et al. so that the device can be operated.

Applicant argues that the combination of Niedermaier et al. and Bergland et al. fails to teach the sensors which are optical scanner for detecting a printed pattern or marks as recited in claims 8 and 9 and that there is no suggestion to combine the references.

As explained above, Bergland et al. teaches clearly the use of the conventional optical scanner for detecting printed pattern or optical marks printed on a web. One of ordinary skill in the art would have been well aware of the conventional use of the optical scanners as taught by Bergland et al. and would have found their use in place of the sensors of Niedermaier et al. to have been obvious. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Niedermaier et al. and Bergland et al. teach the register control means for webs using sensors. Bergland et al. teaches the use of the optical scanner for detecting optical marks printed on a web. Bergland et al. is a relevant prior art. Therefore, the combination of Niedermaier et al. and Bergland et al. renders obvious the structure as recited in claims 8 and 9.

Conclusion

THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Art Unit: 2854

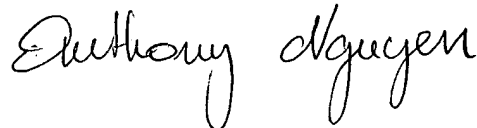
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169.

The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168.

The fax phone number for this Group is (703) 872-9306.

A handwritten signature in cursive script that reads "Anthony Nguyen".

Anthony Nguyen
5/13/055
Patent Examiner
Technology Center 2800